

REMARKS

Claims 1-18 are pending.

In paragraph No. 2 of the Action, claims 1-18 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kodama et al (EP 1 179 750).

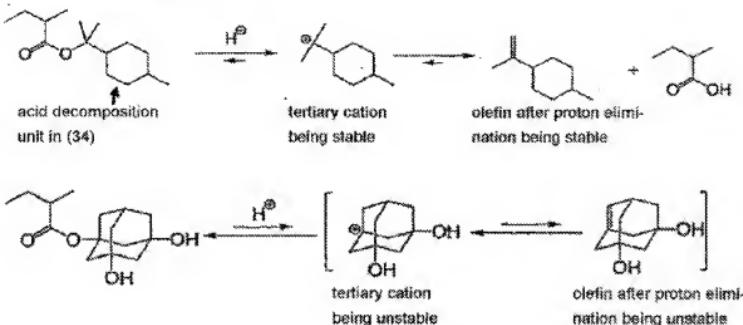
Applicants submit that this rejection should be withdrawn because Kodama does not disclose or render obvious the positive resist composition of the present invention.

Per the Examiner, Applicants have argued that replacing the adamantyl-containing monomer of resin (36) with that of resin (34) of the Kodama reference would cause the polymer to lose its acid decomposition function. The Examiner respectfully disagrees. The Examiner states that both monomers are (meth)acrylic monomers taught to be equivalent in the specification of Kodama, and adding an “almost identical” monomer having substituents should not cause the polymer to lose its acid decomposition function.

In response, and to confirm the patentability of the present resist over Kodama, Applicants submit herewith a Declaration Under 37 C.F.R. § 1.132 of Mr. Fumiaki Nishiyama. Mr. Nishiyama’s Declaration provides evidence of the acid decomposition mechanisms of resins (34) and (36) of Kodama et al EP 1 179 750.

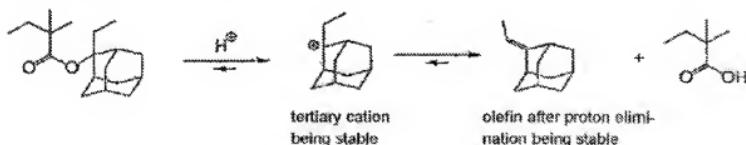
In his Declaration, Mr. Nishiyama explains why the adamantane unit in resin (34) does not have an acid decomposition property, as shown below.

• Regarding resin (34):



As shown in the upper stage, since the tertiary cation generated by decomposition with acid is stable, the acid decomposition proceeds to generate an alkali-soluble group. In contrast, in the lower stage, since the tertiary cation is unstable, the acid decomposition does not proceed so that an alkali-soluble group is not generated.

• Regarding resin (36):



As shown above, since the tertiary cation generated by decomposition with acid is stable, the acid decomposition proceeds to generate an alkali-soluble group. Since no other

acid-decomposition unit is present in resin (36), the resin (36) would lose its acid-decomposition property if this unit were to be replaced.

As a requirement of the present claims, it is essential that the resin increases its solubility in alkali by the action of an acid. However, as is clearly seen from the decomposition mechanisms shown above, replacing the third repeating unit from the left of resin (36) of Kodama with the adamantyl group-containing repeating unit of resin (34), as suggested by the Examiner, would cause the thus-substituted resin (36) to lose its acid-decomposition function, and thus be outside the scope of the present claims. See Mr. Nishiyama's Declaration at page 3.

Furthermore, the Examiner states, the polymers 6, 7, 13 and 14 are cited for their lactone monomers, and their teaching to employ them in similar resins, for example add them to resin (36). The Examiner states: "When this was done, the polymer would still comprise two acrylate monomers and meet the limitations of the instant claims."

Reconsideration is respectfully requested. Resin (36) of Kodama already includes a lactone group. Adding the lactone repeating units of polymers 6, 7, 13 or 14 of Kodama to resin (36) of Kodama would not make the resulting polymer "meet the limitations of the instant claims," contrary to what the Examiner asserts. The reason Kodama's resin (36) is outside the scope of the present claims has to do with the fact that its adamantyl group-containing repeating unit is outside the scope of the adamantyl group-containing repeating unit (AII) of the present claims. Resins 6, 7, 13 and 14 of Kodama cannot be relied upon to make up for this deficiency of resin (36) of Kodama.

Further, Applicants note that with regard to resin 14 of Kodama in particular, Applicants have already presented Declaration evidence that this resin is outside the scope of the present claims because it fails to satisfy the Tg requirements of the present claims.

In view of the above, reconsideration and withdrawal of the § 103(a) rejection based on Kodama et al '750 are respectfully requested.

Allowance is respectfully requested. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Brett S. Sylvester/

Brett S. Sylvester
Registration No. 32,765

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON DC SUGHRUE/265550

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